

REMARKS

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims and the following remarks.

Status of the Claims

Claims 2, 3, 4, 6 and 7 are currently pending in the present application. The Office Action is non-final. Claims 6 and 7 have been amended without prejudice or disclaimer. No new matter has been added by way of the amendments. Claim 6 and 7 were amended to further clarify the invention. Support for amended claims 6 and 7 can be found on page 10, line 15, and page 11, lines 5-12. Thus, no new matter has been added.

Based upon the above considerations, entry of the present Amendment is respectfully requested.

Examiner Personal Interview

Applicants' representative thanks the Examiner and the Examiner's Supervisor for extending the courtesy of the personal interview conducted on December 17, 2008. Applicants' representative discussed the recently submitted Amendment in Response to Non-Final Office Action (submitted on December 12, 2008). The Examiner indicated that it appeared that the rejections under 35 U.S.C. § 112, first and second paragraphs, were resolved. However, the Examiner was still not persuaded that the submitted claim amendments would overcome the rejection under 35 U.S.C. § 103(a) over Yamazaki, EP 0791688 (hereinafter, "Yamazaki") in

view of Smook, Handbook for Pulp & Paper Technologies, section 20.7 (hereinafter, "Smook") (paragraphs 12-20 of Office Action).

Applicants' representative therefore provided the Examiner proposed new claim amendments to overcome the Examiner's rejection. Based on the additional proposed claim amendments, Applicants' representative provided further arguments based on the disclosures at pages 9-12 from the present specification. Applicants' representative also addressed the asserted inherency issue based on Yamazaki by further explaining how the Yamazaki paper could not have the same calcium carbonate load properties of a twin wire wrapper of the present invention. Applicants' representative further explained that the Smook reference was not applicable since it was directed to tissue papers and not for producing cigarette wrapper papers.

After reviewing the new claim amendment in light of the discussion, the Examiner and his supervisor had a clearer understanding of the invention.

Applicants' representatives further indicated that the proposed amended claims would be submitted in the Supplemental Amendment in order to address the obviousness rejection cited above.

Issues Under 35 U.S.C. § 103(a), Obviousness

Claims 2-4, 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki in view of Smook (paragraphs 12-20 of Office Action). Applicants respectfully traverse.

Applicants herein supplement remarks made in the Response dated December 12, 2008. Remarks and applicable U.S. case law from the above-mentioned response are herein

incorporated by reference.

Distinctions over Cited Combination of References

Based on the presently amended claims and the discussion during the Examiner personal interview, Applicants submit that the presently claimed invention is distinct from and unobvious over Yamazaki combined with Smook. Applicants have amended claims 6 and 7, without prejudice or disclaimer of the subject matter contained therein, to recite a “twin wire type wrapper paper.” Additionally, claims 6 and 7 were amended to recite “the difference in the content of the calcium carbonate between an inner region and a surface region of the paper layer is small and, thus, the difference in the calcium carbonate content between the entire paper layer and each layer is considerably small.” Applicants submit that one skilled in the art would understand that the term “small” means negligible.

Applicants again respectfully traverse the Examiner’s assertions regarding inherency.

Based on the amended claims, the claims read as a “twin wire type wrapper paper.” When a paper internally comprises a loading material (calcium carbonate) and is manufactured by a conventional Fourdrinier machine, the amount of the loading material on the wire side is made to be smaller than that on the felt side in accordance with the dehydration from the wire side in the paper layer-forming stage. As a result, the calcium carbonate content of the resulting paper is naturally smaller on the wire side than on the felt side, and the calcium carbonate content is naturally higher than the total calcium carbonate content in the paper.

In contrast, in the presently claimed invention, and as described in the present specification at page 10, lines 8-14, a double-sided dehydration type wire part is used to establish

that the percentage of ash content in a surface layer on each of a top side (synonymous to the felt side) and a bottom side (synonymous to the wire side) of the wrapper paper is lower than a total ash content in the paper. The wrapper paper manufactured by the twin wire type paper making machine, the difference in the content of the loading material between the top side and the bottom side of the paper layer is small and, thus, the difference in the loading material content between the entire paper layer and each layer is considerably small. As indicated in the specification and the newly amended claims, the “difference in the loading material content between the entire paper layer and each layer is considerably small” indicates that the loading material is evenly distributed in the entire paper layer. The distribution of the loading material cannot be achieved in the paper of Yamazaki. Inherently, the Yamazaki paper will have the highest loading material (calcium carbonate) content on the felt surface, and the loading material content gradually decreases toward the wire surface of its wrapper. This is completely different than the present invention, wherein the cited reference discloses a different product. As the Examiner stated in the Office Action, Yamazaki does not disclose or suggest using a double-sided dehydration type wire part to make its wrapping paper. Thus, the presently claimed invention is not inherent in or obvious from Yamazaki since it does not disclose or suggest all of the limitations of the presently pending claims. Applicants submit that one of ordinary skill in the art would not be able to achieve or make the instant invention as discussed in detail above. Yamazaki informs the skilled artisan of a different machine that makes a different product versus that of the present invention.

As Applicants’ representative pointed out in the interview, based on the methods used in Yamazaki, it is physically impossible to obtain the wrapper recited in the present claims, because

a different machine was used to manufacture the wrapper paper of the present claims. With regards to Smook, Smook relates to a tissue paper machine and does not disclose or suggest making a cigarette paper with the loading material by a twin wire former. Applicants' representative pointed out to the Examiner during the interview that Smook refers to a machine that makes tissues and is not applicable to the making of a twin wire type wrapper paper for a smoking article. As indicated on page 316 of Smook (section 20.7, Tissue Grades):

The designation "tissue" covers a wide range of low-weight sheets. Sanitary products comprise facial and bathroom tissues, toweling, and paper napkins. Industrial tissues include condenser, carbonizing and wrapping grades.

Smook does not describe a wrapper paper for a smoking article as a tissue product. Although twin wire tissue formers are mentioned, Smook indicates that potential fouling may occur when running with furnishes containing a secondary fiber. As indicated to the Examiner during the interview, one skilled in the art would not apply a tissue type forming application to a cigarette wrapper. The levels of the calcium carbonate loading material within the cigarette paper would probably cause the fouling issues as described in Smook and not produce a paper with a consistent calcium carbonate load throughout the paper as required within the presently amended claims (See Smook, page 319, first and second columns).

In light of the above presently amended claims and remarks, because there is no disclosure, teaching, suggestion, reason or rationale provided in the Yamazaki reference that would allow one of ordinary skill in the art to arrive at the instant invention as claimed, it follows that the same reference is incapable of rendering the instant invention obvious under the provisions of 35 USC § 103(a). Based upon the above, and applying the *Graham factors* analysis test, it is submitted that a *prima facie* case of obviousness has not been established.

Since the present invention is not obvious in light of Yamazaki, the combinations of Yamazaki and Smook also fail. The secondary reference, Smook, does not cure the deficiencies of Yamazaki. Therefore, the combinations of Yamazaki and Smook do not arrive at the present invention. Based upon the above, and applying the *Graham factors* analysis test, it is submitted that a *prima facie* case of obviousness has not been established for any of the above mentioned claims.

Applicants respectfully request reconsideration and subsequent withdrawal of the above rejection.

CONCLUSION

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

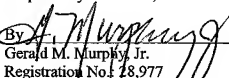
In view of the above remarks, it is believed that claims are allowable.

Should there be any outstanding matters within the present application that need to be resolved, the Examiner is respectfully requested to contact Paul D. Pyla, Reg. No. 59,228, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

Gerald M. Murphy, Jr.
Registration No. 28,977
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicants